



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 1349.1021

In re Patent Application of:

Soon-cheol KWEON et al.

Application No.: 09/455,152

Group Art Unit: 3729

Confirmation No.:

Filed: December 6, 1999

Examiner: D. Tugbang

For: PROCESS FOR MANUFACTURING A FLUID JETTING APPARATUS

RECEIVED
DEC - 3 2001
TC 3700 MAIL ROOM

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is responsive to the Office Action mailed November 6, 2001, having a shortened period for response set to expire on December 6, 2001, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Species A**, claims 1-12 and 14 in response to the preliminary restriction requirement set forth in the Office Action. Further, since the Examiner has indicated that claims 13, 15-19, and 21-26 are generic to both **Species A** and **Species B**, the Applicants' provisional election to **Species A** is therefore to claims 1-19 and 21-26.

II. Applicants Traverse the Requirement

As a general matter, in order for the Examiner to establish a prima facie requirement for a restriction, the Examiner must set forth facts and circumstances showing that 1) the inventions are separate and distinct, and 2) there is a serious burden on the Examiner in searching and examining the separate and distinct inventions together. MPEP 803. In order to meet this prima facie burden, the Examiner is required to provide reasons and/or examples of

both the independence of the inventions, and reasons and/or examples of the serious burden on the Examiner. For instance, MPEP 803.02 notes that the prima facie burden can be met if the Examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02.

A review of the Office Action reveals that the Examiner has not presented facts showing that, even assuming arguendo that Species A and B are separate and distinct, the invention recited in Species A and B are in separate classifications, are recognized as separate in the art, or would involve different fields of search. Thus, the Examiner has not set forth the factual evidence required by the MPEP to meet the prima facie standard for the serious burden on the Examiner.

Further, there has been no showing that the Species exist in such different classifications that the Examiner's burden in searching the relevant art is sufficiently greater than the Applicants' burden in the delay and additional expense in having to protect the additional subject matter by filing a divisional application as to require a restriction.

As such, it is respectfully submitted that, even if the Examiner considers claims 1-12 and 14 to be a separate invention from the invention recited in claim 20, the Applicants respectfully request the Examiner to consider claims 1-12 and 14 (Species A) and claim 20 (Species B) together due at least to the Examiner's not having provided sufficient evidence of a serious burden as required to maintain a prima facie requirement for a restriction.

III. Conclusion

Upon review of references involved in this field of technology, when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Serial No. 09/455,152

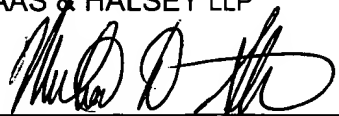
Docket No. 1349.1021

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/29/01

By: 
Michael D. Stein
Registration No. 37,240

700 11th Street, N.W., Ste. 500
Washington, D.C. 20001
(202) 434-1500